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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/255,222	02/22/1999	MICHAEL S. WILLIAMS	P2160/170178	8140

23370 7590 06/03/2004

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EXAMINER

HRUSKOCI, PETER A

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 52704

Application Number: 09/255,222
Filing Date: February 22, 1999
Appellant(s): WILLIAMS ET AL.

MAILED

JUN 03 2004

GROUP 1700

Camilla C. Williams
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 16, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-6 and 36 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

4,911,790	Lindstrom et al.	3-1990
5,234,466	Sargent et al.	8-1993

(10) Grounds of Rejection

Claim 36 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Sargent et al. 5,234,466. Sargent et al. disclose (see col. 1 lines 54-61 and col. 3 lines 4-13) a method for adjusting the pH of a process stream or solution of a pulping or papermaking process substantially as claimed. The claim differs from Sargent et al. by reciting that the process stream is selected from a specific group of streams or solutions. It is submitted that the disclosure of Sargent et al. includes process streams from paper manufacturing which include pulp, and further includes the treatment of any process stream where acid has been traditionally used. It would have been obvious to one skilled in the art to modify the method of Sargent et al. by adding urea sulfate to the recited group of process streams and solutions, to aid in adjusting the pH of the process streams and solutions.

Claims 1-6 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lindstrom et al. 4,911,790 in view of Sargent et al. 5,234,466. Lindstrom et al. disclose (see col. 1 line 55 through col. 2 line 60) that it is known in the art to regulate the pH value of a papermaking process solution with aluminum sulfate substantially as claimed. The claims differ from Lindstrom et al. by reciting the addition of an effective amount of urea sulfate to decrease the amount of aluminum sulfate hydrate required. Sargent et al. disclose (see col. 1 lines 54-61 and col. 3 lines 4-13) that it is known in the art to decrease the amount of acid required by a papermaking process, or adjust the pH of a process stream or solution of a papermaking process, by addition of urea sulfate. It would have been obvious to one skilled in the art to modify the

Art Unit: 1724

method of Lindstrom et al. by addition of urea sulfate in view of the teachings of Sargent et al., to aid in adjusting the pH of the process stream or solution.

(11) Response to Appellant's Arguments

Appellants argue on page 5 of the Brief that the Examiner has not provided any reference teaching that motivates one of ordinary skill in the art to adapt the disclosure of Sargent et al. to the process streams recited in claim 36. It is submitted that the disclosure of Sargent et al. in col. 3 lines 4-13 would provide sufficient motivation to utilize the method of Sargent et al to treat paper manufacturing streams or pulp streams. It is further submitted that the pulping solution, pulping effluent stream, and recycling pulping process stream recited in the instant claims are considered patentably indistinguishable from the paper manufacturing stream containing pulp, which is degraded in the bleaching stage as disclosed in Sargent et al.

Appellants allege on page 6 of the Brief that either Sargent et al. suggests that the process disclosed therein can be applied to any paper process stream where acid has been traditionally used (in which case the disclosure of Sargent et al. reasonably indicates that the inventors had possession of the presently claimed invention as of the filing date of Sargent et al.) , or it does not suggest that the process disclosed therein can be so applied, and the Examiner must cite some reference and provide motivation to combine its teachings with those of Sargent et al. in order to make a sustainable rejection for obviousness. It is submitted that the subject matter of the instant claims on appeal is not entitled to the filing date of Sargent et al. because these claims recite new subject matter "pulping or papermaking process" as in instant claim 1, and "process stream or solution selected from the group as in claims 6 and 36. It is noted that this application is a CIP of

Art Unit: 1724

of two other CIP applications, which claim priority to Sargent et al.. It is further submitted that the teachings of Sargent et al. are considered sufficient to reject the instant claims on appeal under 35 U.S.C. 103 (a) because it would have been obvious to one skilled in the art having the teachings of Sargent et al. before him, to modify the method of Sargent et al. by adding urea sulfate to the recited group of process streams or solutions, to aid in adjusting the pH of the process streams or solutions. Furthermore, appellants have not supplied sufficient factual evidence to support the above allegation.

Appellants argue on pages 7 and 8 of the Brief that Sargent et al. does not teach or suggest that alum in these processes could be replaced by urea sulfate, and Lindstrom et al. does not suggest alum replacement. It is submitted that Lindstrom et al. discloses that aluminum sulfate is traditionally added to paper production stocks or streams to improve filler retention and regulate pH values. It is further noted that Sargent et al. includes motivation for adjusting the pH of paper manufacturing streams or solutions with urea sulfate, to aid in reducing corrosion on metal equipment. It would have been obvious to one skilled in the art having the references before him, to modify the method of Lindstrom et al. by addition of urea sulfate in view of the teachings of Sargent et al., to aid in regulating the pH of the papermaking process streams and in reducing corrosion on papermaking process metal equipment, absent a sufficient showing of unexpected results.

Appellant's citation of case law on pages 7 and 8 of the Brief has been carefully considered but is not deemed pertinent due to the different circumstances involved in the instant application.

Appellants allege on page 8 of the Brief that it is not enough to simply state that it is obvious to replace one pH modifier with another without regard for the underlying chemistry,

Art Unit: 1724

unpredictable downstream effects, and the like, that can result not from the addition of urea sulfate, but also from the removal of alum from the process. It is submitted that a specific chemistry or downstream effect is not recited in claim 1 on appeal. Furthermore, appellants have not presented sufficient probative evidence to support the above allegation.

For reasons advanced above and in the final rejection, the rejection of the claims on appeal is deemed proper, and should be affirmed by the Board of Appeals.

Respectfully submitted,



Peter A. Hruskoci

Primary Examiner

Art Unit 1724

PAH

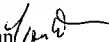
May 27, 2004

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